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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NEELAKANTAN SUNDARESAN,  
VASILIOS MITROKOSTAS, LAUREN OLVER,  
CHI-HSIEN CHIU, JEAN-DAVID RUVINI,  
BADRUL M. SARWAR, and HILL TRUNG NGUYEN

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Appeal 2016-008439  
Application 12/398,950<sup>1</sup>  
Technology Center 3600

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Before HUNG H. BUI, BETH Z. SHAW, and JOYCE CRAIG,  
*Administrative Patent Judges.*

SHAW, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Office Action rejecting claims 1–5, 7, 8, 10, 11, 14–16 and 31–34, all of which are pending on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> According to Appellant, the real party in interest is eBay Inc. App. Br. 2.

<sup>2</sup> Our Decision refers to the Appeal Brief filed December 14, 2015 ("App. Br."); Examiner's Answer mailed July 8, 2016 ("Ans."); and Final Office Action mailed May 14, 2015 ("Final Act.").

## STATEMENT OF THE CASE

Appellants' invention relates to "a method and system for qualification testing in a social network service." Abstract.

Claims 1, 7, and 16 are independent. Claim 1 is illustrative of Appellants' invention, as reproduced below:

1. A method, comprising:

providing access to a collaborative group from a social networking service, the collaborative group to share information among members of the collaborative group, the information being related to a first item type available for purchase via an ecommerce system, the social networking service being provided on a computing system external to the ecommerce system;

providing a qualification assessment to a user of the social networking service via a client machine of the user, the qualification assessment used to determine admittance to the collaborative group;

evaluating, using at least one processor of a machine, the qualification assessment for the user to determine a user score, the qualification assessment comprising questions testing specific knowledge of the user about the first item type available for purchase via the ecommerce system, the user score being based on user answers to the questions provided via the client machine of the user; and

based on the user score satisfying an admittance criterion, admitting the user as a member to the collaborative group, the admitting including providing access to a social network application of the ecommerce system, the social network application facilitating access to the collaborative group via the social networking service over a communication network.

App. Br. 27.

### *Examiner's Rejection*

Claims 1–5, 7, 8, 10, 11, 14–16 and 31–34 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Final Act. 2–3.

### ANALYSIS

With respect to independent claims 1, 31, and 34, the Examiner finds these claims are directed to an abstract idea of “providing access to a restricted group based on a user’s score on a qualification assessment, which could be considered a fundamental economic practice or a method of organizing human activities.” Final Act. 2; *see* Ans. 3. The Examiner also finds additional elements recited in these claims “do not amount to significantly more than the abstract idea itself.” Final Act. 2. According to the Examiner,

The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: mere instructions to implement the idea on a computer. Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself. In the examiner's view, the additional claim elements do not constitute improvements to another technology, technical field, or the functioning of the computer and do not constitute meaningful limitations beyond generally linking the use of the abstract idea to a particular technological environment. Therefore, the claim(s) are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

*Id.* at 2–3.

Appellants present several arguments against the § 101 rejection. App. Br. 8–25; Reply Br. 2–5. Appellants contends the claims are not directed to an abstract idea because: (1) the Examiner’s allegations are not supported by evidence (*id.* at 10–11); (2) “the Office Action provided no comparison of this alleged abstract idea to any other concept, much less to any concept that the courts have already found to be abstract” and the claims are not directed to an abstract idea (*see id.* at 11–18); (3) the claims are

directed to patentable subject matter (*id.* at 18–25); and (4) the Examiner failed to consider the dependent claim elements separately (*id.* at 13–14). According to Appellants, “it is clear that the claims refer to a specially-configured computer, and is clearly directed to an improvement to computer functionality itself.” Reply Br. 4.

We do not find Appellants’ arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 2–3. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.* At the outset, we note the Supreme Court has long held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “‘abstract ideas’ category embodies ‘the longstanding rule that ‘[a]n idea, by itself, is not patentable.’” *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that

“‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellants’ claims are directed to an abstract idea of “providing access to a restricted group based on a user’s qualification assessment.” Ans. 3. All the steps recited in Appellants’ claims, including, for example: (i) “providing access to a collaborative group from a social networking service. . . ,” (ii) “providing a qualification assessment to a user of the social networking service . . . ,” (iii) “evaluating, using at least one processor of a machine, the qualification assessment for the user,” and (iv) “admitting the user as a member,” are abstract processes of providing access, providing, and evaluating information. Dependent claim 7 relates to providing instructions for a first and second view, and dependent claim 11 relates to providing and sending notes, while dependent claim 16 adds an interim user score. Nevertheless, information as such is intangible. *See Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Elec. Power Grp.*

*LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants’ claims to add anything “significantly more” to transform the abstract concept of providing access to a restricted group based on a user’s qualification assessment into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Appellants do not argue any of the steps recited in these independent claims are individually inventive. None of Appellants’ arguments contend that some inventive concept arises from the ordered combination of these steps, and any such contention would be unpersuasive given that they are ordinary steps in data analysis and are recited in an ordinary order.

As recognized by the Federal Circuit in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014), *Bilski*’s “machine-or-transformation” test can also provide a “useful clue” in the second step of the *Alice* framework. *See In re Bilski*,<sup>3</sup> 545 F.3d 943, 954 (Fed. Cir. 2008)

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<sup>3</sup> In *In re Bilski*, the Federal Circuit adopted a “machine-or-transformation” (MoT) test to determine whether a process claim is eligible under 35 U.S.C. § 101. However, the Supreme Court held, in *Bilski v. Kappos*, that the “MoT” test, while a “useful and important clue,” is no longer the sole test for determining the patent-eligibility of process claims under § 101. *See* 130

(en banc). Under *Bilski*'s test, a claimed process is patent-eligible under 35 U.S.C. § 101 if: (1) it is tied to a particular machine or apparatus; or (2) it transforms a particular article into a different state or thing. *Bilski*, 545 F.3d at 954 (citing *Gottschalk*, 409 U.S. at 70). However, Appellants' claims are neither sufficiently "tied to a particular machine or apparatus" nor involved in any type of transformation of any particular article.<sup>4</sup>

Limiting an abstract concept of "providing access to a restricted group based on a user's qualification assessment" to a general purpose computer having generic components such as the "machine" and "interface" recited in Appellants' claims does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *Alice*, 134 S. Ct. at 2358; *see id.* at 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" are not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting "generalized software components arranged to implement an abstract concept [of generating insurance-policy-related

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S. Ct. at 3227. Since *Bilski v. Kappos*, the Supreme Court has created a two-step framework in *Alice Corp.*, 134 S. Ct. 2347, to address whether a claim falls outside of § 101, which we discuss *infra*.

<sup>4</sup> *Alice* also confirmed that if a patent's systems claims are no different in substance from its method claims, they will stand or fall together. 134 S. Ct. at 2360. The same was true of the *Alice* patent's media claims. *Id.*

tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)). While Appellants argue that the claims “refer to a specially-configured computer,” this statement appears to be unsupported by the record.

Lastly, we note Appellants’ dependent claims are neither rooted in computer technology as outlined in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), nor do they seek to improve any type of computer capabilities, such as a “self-referential table for a computer database” outlined in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

Because Appellants’ claims 1–5, 7, 8, 10, 11, 14–16, and 31–34 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

## CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–5, 7, 8, 10, 11, 14–16, and 31–34 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's final rejection of claims 1–5, 7, 8, 10, 11, 14–16, and 31–34.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED